The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED
JUN 29 2004
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUIS J. RODRIGUEZ

Appeal No. 2004-1277
Application No. 09/978,215

ON BRIEF

Before KIMLIN, TIMM and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

REMAND TO THE EXAMINER

Pursuant to our authority under 37 CFR § 1.193(b)(1), last sentence and § 1.196(a), we remand this application to the examiner for consideration of the issues set forth below.

I. The Prosecution History Summary

The examiner relies upon the following references as evidence of unpatentability:

Schieman	2,367,440	Jan. 16, 1945
Wilbur	2,384,223	Sep. 04, 1945
Johnson	3,027,067	Mar. 27, 1962
Stenner	5,607,100	Mar. 04, 1997

Claims 45-49 and 60-70 stand rejected under 35 U.S.C. § 112 first paragraph.[1]

Claims 45-47, 62-64 and 66 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schieman.

Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66, and 67 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Wilbur or Schieman.

Claims 48, 52, 56, 60, and 65 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Wilbur or Schieman and further in view of Stenner.

Claims 59 and 60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Wilbur or Schieman.

[1] This rejection is stated on page 4 of the answer, wherein the examiner states that this rejection is also set forth in the prior Office action (Paper No. 12). In Paper No. 12, on pages 2-3, claim 45 is rejected under 35 U.S.C. § 112, first paragraph (written description). Claims 46-49 are also rejected under 35 U.S.C. § 112, first paragraph (new matter). Claims 68-70 stand rejected under 35 U.S.C. § 112, first paragraph (new matter). Claim 60 is not under appeal. Brief, page 1. Therefore, it appears that only claims 45-49 and 68-70 stand rejected under 35 U.S.C. § 112, first paragraph. That is, it appears that the examiner inadvertently indicated in the answer that claims 61-67 were also rejected in this rejection. We request clarification/correction by the examiner upon return of this application to the jurisdiction of the examiner.

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We further note that although the examiner's answer includes several rejections of claim 60 (as indicated above), yet, claim 60 is not under appeal (as mentioned in footnote 1, supra). See, for example, the bottom of page 1 of appellant's brief, and page 5 of the reply brief. Hence, correction of the status of claim 60 is required in response to this Remand.

The examiner indicates, on page 2 of the answer, that the amendment after final rejection filed on October 17, 2002, Paper No. 13 (hereinafter, referred to as "Amendment C"), "has not been entered". No discussion of any arguments set forth in Amendment C is provided in the Answer. There is no indication that the examiner considered any portion of Amendment C as directed by the Decision on Petition. Hence, the examiner's handling of Amendment C is in direct contradiction to the Decision on Petition rendered on June 2, 2003 of Paper No. 33, as pointed on by appellant in the Reply Brief.

II. The Decision on Petition

The Decision on Petition was in response to a Petition to the Commissioner to enter amendment C, that was filed by appellant on January 9, 2003 (Paper No. 18). At the time appellant filed the brief on March 7, 2003, no decision in connection with the Petition was rendered regarding entry of amendment C.

Thereafter, a decision was rendered in Paper No. 33, filed on June 2, 2003. The examiner's answer was filed on August 27, 2003, after the Decision on Petition was rendered on June 2, 2003. Appellant filed a Reply Brief on September 8, 2003.

With respect to the particular issues regarding Amendment C, the Decision on Petition states that arguments "that applied to the claims and to exhibits and attachments of record in the

application prior to the final rejection **will be considered** to be of record" [emphaisis added]. The Decision on Petition further states that arguments discussing why the amendments to the claims proposed in Paper No. 13 make those claims allowable are not relevant, whether applicant wishes to consider them as entered in the record or not, since those amended claims filed in Paper No. 13 are not of record. See pages 1-2 of the Decision on Petition filed on June 2, 2003.

In summary, therefore, with respect Amendment C, the Decision on Petition instructs the examiner to consider arguments that relate to claims and to exhibits and attachments of record in the application prior to the final rejection.

Therefore, upon return of this application to the jurisdiction of the examiner, the examiner must (1) meticulously identify which arguments set forth in Amendment C relate to claims and to exhibits and attachments of record in the application prior to the final rejection, and (2) clearly discuss such arguments, exhibits, attachments, and (3) make determinations therefrom, and carefully explain all basis for such determinations.[2]

The examiner must also meticulously identify the arguments that apply to the claims and specification as proposed to be amended in amendment C, which are not to be considered by the examiner.

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[2] We note that beginning on page 2 of the Reply Brief, appellant discusses what parts of Amendment C must be considered. Upon return of this application to the jurisdiction of the examiner, consideration of this point made by appellant, as well as consideration of every other comment made in the Reply Brief, is necessary.

In this way, the record will be clear that the examiner has followed the instructions of the Decision on Petition. The record will also be clear as to which arguments, exhibits, and attachments of Amendment C have been considered by the examiner. Hence, the record will be clear as to the examiner's position with respect to any arguments made by appellant corresponding to arguments presented in Amendment C that should have been considered by the examiner as instructed by the Decision on Petition.

We also observe that appellant alleges that new issues have been raised in the examiner's Answer filed August 27, 2003. We instruct the examiner to specifically address this allegation.

We authorize the examiner to re-open prosecution in this case if deemed appropriate by the examiner based upon the issues disccussed herein.

III. Conclusion

We remand this application to the examiner to (1) properly consider aspects of the amendment filed on October 17, 2002 (Amendment C) pursuant to the instructions set forth in the Decision on Petition of Paper No. 33 and as discussed above, and (2) address any other issues discussed above.

This application, by virtue of its special status, requires an immediate action. MPEP § 708.01(d) 8th Edition, Revision 1, February 2003. It is important that the Board be informed promptly of any action affecting the appeal in this case.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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)BOARD OF PATENT
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